1 2	BoxInterferences@uspto.gov Telephone: 571-272-4683	Declared:	Paper 1 20 February 2009
3			
4	UNITED STATES PATENT	AND TRADEMA	RK OFFICE
5	BOARD OF PATENT APPE	ALS AND INTER	RFERENCES
6			
7	-		
8	Patent Interferer	nce 105,689 Mcl	<
9	Technology	Center 1600	
10			
11			
12	ANTHONY F. HADFII		
13	MICHAEL W. WINKELY, P		
14	JAMES A. PROVOST, AERI		
15	BRENTON W. RUSSEL	L and BEAT T.	WEBER
16			
17		73,838 B2,	
18	Junior	Party,	
19			
20	\	<b>/</b> .	
21			
22	THOMAS P. JERUSSI and CH	IRISANTHA H. S	SENANAYAKE,
23	A and the attent	11 001 510	
24		11,091,518,	
25	Senioi	r Party.	
26			
27 28	Defere Fred F. McKelvey Conjer	Administrativa [	Patant ludas
28 29	Before: Fred E. McKelvey, Senior	Administrative F	raterit Juuge.
30	DECLA	RATION	
31	DECLA	I A I ION	
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1	Part A
2	Declaration of Interference
<i>3</i>	An interference is declared pursuant to 35 U.S.C. § 135(a).
5	Details of the application, patent, count and claims designated
6	as corresponding or as not corresponding to the count appear in
7	Parts E and F.
8	
9	Part B
10	Designation to manage
11	
12	Senior Administrative Patent Judge Fred E. McKelvey has been
13	designated to manage the interference. 37 CFR § 41.104(a).
14	2.10
15 16	Part C Standing Order
17	Standing Order
18	A copy of a STANDING ORDER (3 Jan. 2006) (Paper 2)
19	accompanies this DECLARATION.
20	The STANDING ORDER applies to this contested case.
21	Part D
22	Initial Conference Call and Motions Lists
23 24	Conformed Call
	Conference Call
25	A conference call (together with a conference call in
26	Interference 105,685) to set dates for action in this contested case is
27	scheduled for:
28	2:00 p.m. (1400 hours Eastern Time) on 1 April 2009.
29	The Board will initiate the conference call.
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1	Motions Lists
2	On or before:
3	Noon (1200 hours Eastern time) on 26 March 2009,
4	each party shall file, and on or before:
5	5:00 p.m. (1700 hours Eastern time) on 26 March 2009,
6	each party shall serve a notice stating the relief the party requests,
7	i.e., a motions list including motions the party seeks authorization to
8	file. 37 CFR §§ 41.120(a) & 41.204; STANDING ORDER ¶¶ 104.2.1,
9	120 & 204.
10	The default procedure for filing and serving motions lists is that
11	motions lists are to be <i>filed</i> before being <i>served</i> .

motions lists are to be *filed* before being *served*.

By filing before service, one party will not have access to an opponent's motions list prior to the filing of the party's motions list.

Nevertheless, the parties may mutually agree to discuss and serve motions lists at any time prior to the date and time motions lists are due.

The following shall be included in motions lists.

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- Proposed motion for benefit (i.e., to be accorded an (1) earlier constructive reduction to practice) must identify the application(s) for which benefit will be sought.
- 2.1 Proposed motion to attack benefit must identify the 22 application(s) to be attacked.
  - (3) Proposed motion seeking judgment against an opponent based on alleged unpatentability must identify the statutory basis for the alleged unpatentability and:
    - if based on prior art, identify the prior art; (a)

- (b) if based on the first paragraph of 35 U.S.C.

  § 112, (i) identify whether written description, enablement or best
  mode will be the basis for the motion, and (ii) briefly identify the basis
  for any alleged unpatentability;
- (c) if based on an alleged failure to comply with
   35 U.S.C. § 135(b), briefly identify the reason;
   (d) if based on the second paragraph of 35
- 8 U.S.C. § 112, identify the limitation which is believed to be indefinite.
- 9 (4) Proposed motion based on no interference-in-fact 10 shall briefly identify the reason no interference-in-fact is believed to 11 exist.

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- (5) Proposed motion to designate additional claims as corresponding to a count or as not corresponding to a count shall identify the claims involved.
- (6) Proposed motion to add or substitute a new countshall explain why the added or substitute count is necessary.

A motions list shall not contain any "reservation clause"
whereby a party purports to reserve a right to file additional motions.
Additional motions are those authorized by the Board consistent with
the rules.

A sample schedule for taking action during the motions phase of the interference appears as Form 2 (page 69) of the STANDING ORDER.

Counsel are encouraged to discuss the schedule prior to the conference and agree to on times for taking action generally consistent with the sample schedule.

A typical motions phase last about eight (8) months.

- The parties should be prepared at the conference to justify any
- 2 request for shorter or longer time periods.

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1		Part E
2	Id	entification of the Parties
3 4		gnment of Exhibit Numbers
5		ting Settlement Discussions
6		ang comon picacoions
7		Junior Party
8 9	Inventors:	Anthony F. Hadfield, NY
10	inventors.	Syed M. Shah, NJ
11		Michael W. Winkley, NY
12		Karen W. Sutherland, NY
13		James A. Provost, UK
14		Aeri Park, IN
15		Rex A. Shipplett, IN
16		Brenton W. Russell, IN
17		Beat T. Weber, CH
18		
19	Patent:	U.S. Patent, 6,673,838 B2
20		granted 6 January 2004
21		based on application 10/073,743,
22		filed 11 February 2002
23		
24	Title:	Succinate salt of O-desmethyl-venlafaxine
25 26	Real party in interest:	Wyeth
27		

1		Senior Party
2 3 4 5	Inventors:	Thomas P. Jerussi, MA Chrisantha H. Senanayake, MA
6 7 8	Application:	Application 11/091,518, filed 29 March 2005
9 10 11	Title:	O-desmethylvenlafaxine and methods of preparing and using the same
12 13	Real party in interest:	Sepracor Inc.
14	Ass	signment of Exhibit Numbers
15	Senior party:	Exhibit Numbers 1001 through 1999.
16	Junior party:	Exhibit Numbers 2001-2999.
17	Board:	Exhibit Numbers 3001-3999.
18 19 20 21	Initiating Settlement Discussions STANDING ORDER ¶ 126.1 (Paper 2, pages 40-41)	
22	The senior party	is responsible for initiating settlement
23	discussions required b	by the STANDING ORDER.

1 2	Part F Count and Claims of the Parties
3	Count and Claims of the Farties
4	The composition of claims 23, 25 or 26 of Hadfield
5	or
6	the composition of claims 1 or 64 of Jerussi.
7	Hadfald alain 00 years
8	Hadfield claim 23 reads:
9	A pharmaceutical composition comprising O-desmethyl
10	venlafaxine succinate and a pharmaceutically acceptable
11	carrier or excipient.
12	Hadfield claim 25 reads:
13	A pharmaceutical dosage form comprising a
14	therapeutically effective amount of O-desmethyl
15	venlafaxine succinate and a pharmaceutically acceptable
16	carrier or excipient.
17	Hadfield claim 26 reads:
18	An oral dosage form comprising a therapeutically effective
19	amount of O-desmethyl venlafaxine succinate and a
20	pharmaceutically acceptable carrier or excipient.
21	Jerussi claim 1 reads:
22	A pharmaceutical composition which comprises (±)-O-
23	desmethylvenlafaxine succinate and a pharmaceutically
24	acceptable carrier or excipient, wherein $(\pm)$ -O-desmethyl-
25	venlafaxine is present at an amount of about 50 mg.
26 27	Jerussi claim 64 reads:
28	A pharmaceutical composition which comprises (±)-O-
29	desmethylvenlafaxine succinate and a pharmaceutically

1	acceptable	carrier or excipient, wherein (±)-O-desmethyl-
2	venlafaxine	e is present at an amount of about 100 mg.
3		
4	The claims of the	e parties are:
5 6	Hadfield:	1-46
7 8	Jerussi:	1, 12 and 60-69
9	00.000	1, 12 4.14 66 66
10	The claims that o	correspond to Count 1 are:
11 12	Hadfield:	23-34 and 46.
13 14 15	Jerussi:	1, 12 and 60-69
16 17	The claims that c	do not correspond to Count 1 are:
18 19	Hadfield:	1-22 and 35-45
20 21	Jerussi:	None

1	The parties are	accorded an earlier constructive reduction to
2	practice (i.e., benefit f	or the purpose of priority) of the following
3	applications:	
4	Hadfield:	None
5		
6	Jerussi:	Application 10/720,134,
7		filed 25 November 2003
8		[involved in Interference 105,685]
9		
10		Application 09/527,422,
11		filed 17 March 2000

1 2	Part G Heading to be Used on Papers
3	The fellowing handling shall be used on all growns filed in this
4	The following heading shall be used on all papers filed in this
5	interference [STANDING ORDER ¶ 106.11 (Paper 2, page 20)].
6 7 8 9	Filed by: [name of party] Paper _ [Name of attorney] Date filed: [enter date emailed to Board [Email address of attorney] [Telephone number of attorney]
1 2 3	UNITED STATES PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES
4 5 6 7	Patent Interference 105,689 McK Technology Center 1600
8 9 20 21 22	ANTHONY F. HADFIELD, SYED M. SHAH, MICHAEL W. WINKELY, KAREN W. SUTHERLAND, JAMES A. PROVOST, AERI PARK, REX A. SHIPPLETT, BRENTON W. RUSSELL and BEAT T. WEBER
23 24 25	Patent 6,673,838 B2, Junior Party,
26 27	٧.
28 29 30 31 32	THOMAS P. JERUSSI and CHRISANTHA H. SENANAYAKE,  Application 11/091,518,  Senior Party.
34	Title of Paper, e.g., [Name of party] MOTION 1
35 36	Part H

1	Order Form for Requesting File Copies
2	When requesting file copies, a party shall use STANDING
3	ORDER Form 4 (page 71).
4	Use of form 4 will expedite processing of any request.
5	a party should attach to any request for file copies a photocopy
6	of Part E (for involved files) and Part F (for benefit files) of this
7	DECLARATION with a hand-drawn circle around the patent and
8	application files for which a copy of a file wrapper is requested.
9	The parties are advised that a single order for file copies may
10	be filled by the Office of Public Records at more than one time.
11	STANDING ORDER ¶ 109.2 (Paper 2, pages 25-27).
12	

## Part I Required Paragraph of Affidavits and Declarations

The Board has experienced cases in which a witness has belatedly advanced reasons why the witness would be unable to appear for cross examination at a reasonable time and place in the United States.

Consequently, to prevent surprise and hardship to the party relying on the testimony of a witness, the following paragraph must be included on the signature page of all affidavits (including declarations) filed in this case. STANDING ORDER ¶ 157.2 (Paper 2, pages 52-53).

22.

In signing this affidavit, I understand that the affidavit will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I also acknowledge that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

1 (via electronic mail): Attorney for Jerussi 3 (real party in interest Sepracor Inc.): 4 5 Thomas E. Friebel, Esq. 6 Jones Dav 7 222 East 41st Street 8 New York, NY 10017 9 10 Tel: 212-326-3939 11 Fax: 212-755-7306 tefriebel@jonesday.com 12 Email: 13 14 Anthony M. Insogna, Esq. Jones Dav 15 12265 El Camino Real, Suite 200 16 San Diego, CA 92130 17 18 19 Tel: 858-314-1200 20 Fax: 858-314-1150 21 Email: aminsogna@ionesdav.com 22 Attorney for Hadfield 23 24 (real party in interest Wyeth): 25 Steven P. O'Connor, Esq. 26 27 FINNEGAN, HENDERSON, FARABOW. 28 GARRETT & DUNNER L.L.P. 29 11955 Freedom Drive 30 Reston, VA 20190-5675 31 32. Tel: 571-203-2718 Fax: 33 202-408-4400 34 Email: steven.oconnor@finnegan.com

35

- 1 Carlos M. Tellez, Esq.
- 2 FINNEGAN, HENDERSON, FARABOW,
- 3 GARRETT & DUNNER L.L.P.
- 4 901 New York Avenue, NW5 Washington, D.C. 20001-4413
- 6 wasi
- 7 Tel: 202-408-4123
- 8 Fax: 202-408-4400
- 9 Email: carlos.tellez@finnegan.com